

Applicant(s): B. Silverman
Application No.: 10/620,919
Examiner: Michael J. Araj

Remarks

Claims 1, 3-5, 7, 10, 11, 13-21, and 26 remain pending in the application and are presented for the Examiner's review and consideration. Applicant believes the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

35 U.S.C. § 103(a) Rejections

Claims 1, 3-5, 7, 10, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,693,616 to Roaf ("Roaf") in view of U.S. Patent Publication No. 2004/0117016 to Abramson ("Abramson"). Claims 17-21 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roaf in view of Abramson, and further in view of U.S. Patent No. 1,950,799 to Jones ("Jones"). For the reasons set forth below, Applicant respectfully submits that these rejections should be withdrawn.

Abramson does not qualify as prior art and therefore cannot be used either under Section 102 or 103 in any rejection. Specifically, Abramson was filed in the United States September 16, 2003 and the present application was filed in the United States July 16, 2003, i.e. two months prior. Accordingly, Applicant submits that Abramson is not prior art. As a result, the rejection of the claims under § 103(a) should be withdrawn.

Even if Abramson did qualify as prior art, Applicant submits that combination of cited references still fails to teach or suggest the invention as claimed. At a minimum, Applicant disputes the assertion that the preamble should not be given any patentable weight. Applicant submits that the preamble is 'necessary to give life, meaning, and vitality' to the claim. As set forth in the MPEP:

"If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim."
Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333,

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68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.). *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.). MPEP §2111.02

The claim preamble of the present invention recites "An internal long bone fracture fixation device for the treatment of a long bone fracture." Analogous to *Jansen v. Rexall Sundown, Inc.*, the recitation of "for treatment of a long bone fracture" gives life and meaning to the preamble's statement of purpose. Similarly, analogous to *Kropa v. Robie*, "internal long bone fracture fixation device" is essential to point out the invention defined by claims to a device comprising a plurality of bone plates and at least one transverse element. It is only by that phrase that it can be known that the subject matter defined by the claims is comprised of an internal long bone fracture fixation device. Therefore, the preamble serves to further define the structure of the article produced.

Withdrawn Claims

Claims 13-16 and claims 22-25 were withdrawn from consideration. As provided above claims 1 and 17 are submitted to be patentable over the cited prior art. As claims 13-16 depend from independent claim 1 and claims 22-25 depend from independent claim 17, Applicant respectfully requests rejoinder of the claims and submits that these dependent claims are also patentable at least for the same reasons.


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Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No fee is believed to be due for the Response. Please charge any additional fees (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 7996-A03-003).

Respectfully submitted,



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